

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,
AMAZON.COM SERVICES LLC, and
AMAZON WEB SERVICES, INC.,
Petitioners

v.

SOUNDCLEAR TECHNOLOGIES LLC,
Patent Owner

U.S. Patent No. 11,069,337

Issue Date: July 20, 2021

Title: VOICE-CONTENT CONTROL DEVICE, VOICE-CONTENT
CONTROL METHOD, AND NON-TRANSITORY STORAGE MEDIUM

Inter Partes Review No. IPR2025-00565

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER EXHIBIT LIST

Exhibit No.	Description
2001	Docket Printout of CA No. 1:24-01283 (EDVA)
2002	Order from Judge Anthony Trenga, dated January 10, 2025 (Dkt. 84)
2003	Scheduling order, dated September 23, 2024 (Dkt. 34)
2004	Final Scheduling Order, dated October 18, 2024(Dkt. 55)
2005	Judge Anthony Trenga’s median time to trial available at https://law.lexmachina.com/shared/eyJzaGFyZWRFcGFnZV9pZCI6MTI3OTMxfQ.aA_aRw.A2n-SunBPfmUP2aka341_-3f27g
2006	Excerpts from the Motion to Stay hearing transcript, dated March 26, 2025
2007	Joint proposed scheduling order (Dkt. 48)
2008	Reply in Support of Motion to Stay, dated March 20, 2025 (Dkt. 129)
2009	Full prosecution history of U.S. Patent No. 11,069,337
2010	TransPerfect Blog – The Evolution of AI in Language Processing and Its Impact on IP/Patents
2011	Median Time to Disposition in Cases Terminated After Hearing or Submission, UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, available at https://www.cafc.uscourts.gov/wp-content/uploads/reports-stats/FY2024/MedianDispositionTime-Merits.pdf .

Patent Owner SoundClear Technologies LLC (“SoundClear” or “Patent Owner”) submits this Preliminary Response respectfully requesting that the Board deny institution of the Petition for *Inter Partes* Review (“Petition”) filed by Amazon.com, Inc., Amazon.com Services LLC, and Amazon Web Services, Inc. (“Amazon” or “Petitioner”) challenging claims 1-5 (“the challenged claims”) of U.S. Patent No. 11,069,337 (Ex. 1001) (“’337 patent”).

I. INTRODUCTION

The prior art cited in the Petition lacks the recited voice classification in the ’337 patent. Amazon cites no express disclosure of any such classification. Amazon instead improperly relies on the expert declaration to mirror attorney argument in the Petition. Both add the “first voice” and “second voice” as annotations to the tables from the Shin and Shimomura prior art references.

Grounds 4 and 5 demonstrate the above deficiencies by comparison. They purport to be obviousness grounds. But they are each improper, and cursory, attempts to create a stepping stone reference in between assessing the claims and prior art. Amazon combines references in those grounds based simply on similarity of the single-variable tables in those references. It skips over the controlling *KSR* and *Graham* standards on obviousness. Its analysis is not linked to any identified difference between the claims and the prior art.

The Petition does support either position with any inherency argument. Nor could it. Shin and Shimomura were concerned only with determining distance between a device and a single user. Shimomura mentioned user identification, but not in connection with any related disclosure or in the manner claimed. The Petition challenges voice classification claims based largely on a short table that does not mention voices and instead addresses a single variable: distance. Petitioner's prior art references, Shin and Shimomura, disclose similar such tables.

Amazon also misrepresents the record because Amazon's Grounds 1, 2, and 5 rely on Shin, yet the Examiner already issued the claims over Shin. Amazon introduces a translated version of Shimomura in Ground 3 as a backup. But Shimomura is merely cumulative of Shin. In fact, it bears even less relation to the '337 patent than Shin.

The Board should deny institution of this Petition because Petitioner confuses the obviousness and anticipation standards, fails to address *Graham* factor 2 in its obviousness analysis, and improperly uses "and/or" to create confusion in their positions.

II. LEGAL STANDARDS

A. 35 U.S.C. § 314(a)

To institute an *inter partes* review, the Board must determine that the Petition shows a “reasonable likelihood that the petitioner would prevail with respect to at least 1 of the challenged claims.” 35 U.S.C. § 314(a).

B. Anticipation

“To anticipate a claim, a prior art reference must disclose each and every element of the claim, either explicitly or inherently.” *Adasa Inc. v. Avery Dennison Corp.*, 55 F.4th 900, 910 (Fed. Cir. 2022) (citing *Eli Lilly & Co. v. Zenith Goldline Pharms., Inc.*, 471 F.3d 1369, 1375 (Fed. Cir. 2006)). The “hallmark of anticipation is prior invention, the prior art reference--in order to anticipate under 35 U.S.C. § 102--must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). “The question of what a reference teaches and whether it describes every element of a claim is a question for the finder of fact.” *Adasa Inc.*, 55 F.4th at 910 (citing *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1221 (Fed. Cir. 2003)).

C. Obviousness

The Supreme Court and Federal Circuit provide core principles that must be considered in every obviousness determination. First, obviousness arguments “should be made explicit.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418, 127 S. Ct. 1727, 1741 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (emphasis added)). Second, “rejections on obviousness grounds cannot be sustained by mere conclusory statements ...” *Id.* Third, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*

The entire invention as a whole must be considered when the petitioner combines references. 35 U.S.C. §103 requires that the entire claimed invention be considered, not simply a missing limitation. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004) (“The ‘as a whole’ instruction in title 35 prevents evaluation of the invention part by part. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result—often the very definition of invention.”); *Princeton Biochemicals, Inc. v. Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005); *Allergan, Inc. v. Apotex, Inc.*, 754 F.3d 952 (Fed. Cir. 2014). Additionally, “[o]bviousness requires more than a mere showing that the prior art includes separate references covering each separate

limitation in a claim under examination.” *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). When combining references, the petitioner must show that a POSITA “would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention.” *Id.*

Prior art must be considered as a whole. “It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965); *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 449-49 (Fed. Cir. 1986) (district court ignored portions of the reference that led away from obviousness). *Merck Sharp & Dohme B.V. v. Warner Chilcott Co, Merck Sharp & Dohme B.V.*, 711 F. App’x 633 (Fed. Cir. 2017) is instructive:

“[A] patent composed of several elements is not proved obvious *merely by demonstrating that each of its elements was, independently, known in the prior art.*” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Even if all elements of the claim were known, we still must resolve whether a person of ordinary skill in the art would have found it obvious to combine these elements or modify them in a way that meets the claim. In making this inquiry, we have cautioned that “[t]he inventor’s own path itself never leads to a conclusion of obviousness;

that is *hindsight*.” *Otsuka Pharm. Co. v. Sandoz, Inc.*, 678 F.3d 1280, 1296 (Fed. Cir. 2012). Thus, it is *improper to combine references “like separate pieces of a simple jigsaw puzzle” without “explain[ing] what reason or motivation one of ordinary skill in the art at the time of the invention would have had to place these pieces together.”* *InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1349 (Fed. Cir. 2014).

711 F. App’x 633 (emphasis added).

Further, it is improper to combine references based on hindsight. A combination may be the result of improper hindsight where the secondary reference provides an advantage not relevant to the primary reference. *See, e.g., In re Omeprazole Patent Litig. v. Apotex Corp.*, 536 F.3d 1361, 1380 (Fed. Cir. 2008) (“the district court reasonably concluded that a person of ordinary skill in the art would not have seen any need to apply to [the primary reference] the teachings of the [secondary] references disclosing subcoatings” where the primary reference did not suggest any problem with the coating it had.). Further, a combination may be the result of improper hindsight where the secondary reference provides only redundant advantages. *Kinetic Concepts, Inc., v. Smith and Nephew, Inc.*, 688 F. 3d. 1342, 1369 (Fed. Cir. 2012) (where two “references independently accomplish[ed] similar functions, namely, draining fluids” and the “device[s in each reference] independently operate[d] effectively, a person having ordinary skill in the art, who

was merely seeking to create a better device to drain fluids from a wound, would have no reason to combine the features of both devices into a single device.”).

If a proposal for modifying the prior art in an effort to achieve the claimed invention causes the art to become inoperable or destroys its intended function, then the requisite motivation to make the modification would not have existed. *In re Fritch*, 972 F.2d 1260, 1265 n.12 (Fed. Cir. 1992) (“A proposed modification [is] inappropriate for an obviousness inquiry when the modification render[s] the prior art reference inoperable for its intended purpose.”); *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959) (holding the suggested combination of references improper under § 103 because it “would require a substantial reconstruction and redesign of the elements shown in [a prior art reference] as well as a change in the basic principles under which [that reference’s] construction was designed to operate”); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (“[The reference] teaches a liquid strainer which relies, at least in part, upon the assistance of gravity to separate undesired dirt and water from gasoline and other light oils. Therefore, it is not seen that [the reference] would have provided any motivation to one of ordinary skill in the art to employ the [disclosed] apparatus in an upside down orientation. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”).

The prior art references cannot just be compatible. “Mere compatibility of the references is . . . not sufficient” to support obviousness. *Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2018-00827, Paper 9, 17 (PTAB Oct. 16, 2018) (citing *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017)). Further, “[i]n determining whether there would have been a motivation to combine prior art references to arrive at the claimed invention, it is insufficient to simply conclude the combination would have been obvious without identifying any reason why a person of skill in the art would have made the combination.” *Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1366 (Fed. Cir. 2017).

Amazon’s obviousness grounds must meet these legal requirements.

III. CLAIM CONSTRUCTION

A. All Claims Will be Given Their Plain and Ordinary Meaning in this IPR

The Petition relies on plain and ordinary meaning of every limitation in every claim. Pet., 8. Amazon provides no proposed construction. Nor will SoundClear.

B. Amazon’s Inconsistent Claim Constructions Approach Is a Non-Discretionary Factor that Supports Denial

Amazon took the exact opposite approach before the district court. Amazon stated that it is a matter of “when,” not “if,” it will seek to construe the claims. At a hearing on March 26, Amazon’s counsel stated: “this Court, *when* it does claim

construction....” Ex. 2006, 3-4 (emphasis added); *id.*, 3 (referencing the district court’s eventual “own claim construction”); *id.*, 7 (arguing that “[y]ou can say there’s no claim construction necessary to resolve those validity issues, but there is claim construction necessary for other issues in the case.”).

In short, Amazon will seek to invalidate the patents by applying a broad scope of the claims before this Board.¹ It will then turn around and seek to avoid infringement by seeking to have the district court issue narrowing constructions.²

That approach is patently unfair. Claims must be interpreted the same for invalidity and infringement: “It is axiomatic that claims are construed the same way for both invalidity and infringement.” *Amgen Inc. v. Hoechst Marion Roussel*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 842 F.2d 1275, 1279 (Fed. Cir. 1988)). “A patent may not, like a nose of wax, be twisted one way to avoid anticipation and another to find infringement.”

¹ *Roku, Inc. v. Universal Elecs., Inc.*, No. 2023-1019, 2024 U.S. App. LEXIS 14723, at *9-*10 (Fed. Cir. June 18, 2024) (finding “no clear basis for deviating from the disputed term’s broad plain and ordinary meaning” (emphasis added)); *see also VSolvit, LLC v. United States*, 166 Fed. Cl. 201, 214 (2023) (plain and ordinary meaning can be “rather broad”).

² “We depart from the plain and ordinary meaning of claim terms based on the specification in only two instances: lexicography and disavowal.” *Talexmedical, LLC v. Becon Med. Ltd.*, Nos. 2021-2069, 2021-2071, 2021-2109, 2021-2110, 2022 U.S. App. LEXIS 20252, at *14 (Fed. Cir. July 22, 2022) (citations omitted). Amazon has identified no lexicography. And disavowal can only narrow a claim.

Amazon.com, Inc. v. Barnesandnoble.com, Inc., 239 F.3d 1343, 1351 (Fed. Cir. 2001) (citing, among others, *White v. Dunbar*, 119 U.S. 47, 51 (1886)).

The Board’s FAQ 11 expressly also prohibits Amazon’s approach as a non-discretionary matter. It states that the non-discretionary considerations “may include for example: (1) claim construction issues . . .” (citing *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 (PTAB Dec. 13, 2024)). The Board, in *Cambridge*, stated that “[a]t a minimum, the Petition should have explained why the plain and ordinary meaning of the [the] terms should apply in this proceeding (why the inconsistent positions are warranted) or set forth an alternative [] claim construction.” *Cambridge*, IPR2024-00952, Paper 12, 8.

To be sure, inconsistent positions are sometimes allowed. But only when they are justified. And only when they avoid risking inconsistent results. The *10x Genomics, Inc. v. Bio-Rad Lab ’ys, Inc.*, IPR2020-00086, Paper 8, 18 (PTAB Apr. 27, 2020) decision *Cambridge* cites provides an example. *Cambridge*, IPR2024-00952, Paper 12, 8. It is distinguishable from Amazon’s approach for at least four reasons.

First, *10x Genomics* involved a dispute that had been crystalized. Both parties knew what the issue was and what each side’s positions were. *10x Genomics*, IPR2020-00086, Paper 8, 18-21. Amazon has not identified what its proposed constructions will be.

Second, the *10X Genomics* petitioner did seek to take inconsistent positions before two adjudicative bodies. It submitted alternative positions, in the same proceeding, to the same body (the Board). Amazon has not disclosed its alternative positions for the Board to consider.

Third, the factual records will diverge between the Board and the district court case—which was not an issue in *10x Genomics*. Amazon stated that it will introduce extrinsic evidence supporting its claim construction positions in the district court. That evidence will not be available in the IPR proceedings.

Fourth, in *10x Genomics*, the petitioner had proposed a narrowing construction, which would have guaranteed a consistent record. *Id.*, 11-12. It thus presented a more conservative position on invalidity. The petitioner only presented the broader, alternative grounds, in response to the *patent owner's* broader construction. *Id.*, 12. In short, the petitioner presented the Board with two options: (1) address invalidity under a narrow construction, which would have made petitioner's position more difficult or (2) proceed under a construction the patentee proposed, which patentee would not be able to disavow in any later proceeding. Amazon's approach is the exact opposite in every respect.

The two cases on which Amazon relies are inapplicable. Pet., 8. (citing *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017

(Fed. Cir. 2017) and *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

First and foremost, if there were a rule of law allowing a party to orchestrate proceedings for the purpose of taking divergent positions, it would be plainly stated. Manipulating two proceedings for strategic benefit is not the type of gambit that would be incidentally countenanced. It would not be announced, for example, (1) when reviewing results in hindsight on appeal or (2) when determining, after all issues have been put on the table, whether claim construction should have been conducted on a particular issue. *Nidec*, 868 F.3d at 1017. Or when determining at which point in a case it makes the most sense, from a logistical standpoint, to conduct claims construction. *Vivid Techs.*, 200 F.3d at 803 (rejecting a “uniform rule” of when, during discovery, to conduct claims construction).

The *Nidec* court analyzed proposed constructions in hindsight—at the conclusion of the administrative trial proceedings. It determined, *post hoc*, that the parties’ disagreement on a proposed construction/interpretation had no bearing on the court’s determination. *Nidec*, 868 F.3d at 1017 (“Whether or not Nidec is correct, the result does not change.”).

The *Vivid Technologies* court simply determined that there is no set rule as to when claims construction should occur during a district court case schedule. 200 F.3d at 803. It did not address making final rulings on one dispositive issue before

conducting claims construction to decide another dispositive issue. Indeed, the *Vivid Technologies* court referred to construing claims to resolve a “controversy.” *Id.* That includes all disputes between the parties. Infringement and validity are both at issue in the present controversy between Amazon and SoundClear. So even under *Vivid*, the claims must be construed—consistently—to resolve *all* issues, not just infringement.

Further, the *Vivid Technologies* court identified two core principles that prevent Amazon’s gambit. First, it described bedrock law that “the meaning and scope” of claim terms be determined *before* the claims are applied to the accused device or method or prior art—not after. *Id.*; *see also Markman v. Westview Instruments*, 517 U.S. 370, 384 (1996); *In re Aoyama*, 656 F.3d 1293, 1296 (Fed. Cir. 2011) (“The second step involves comparing the claims to the prior art.”) Second, *Vivid Technologies* repeated that “the Rules shall be construed and administered to secure the just, speedy, and inexpensive determination of every action.” 200 F.3d at 804 (citing Fed. R. Civ. P. 1) (cleaned up). Amazon’s approach contradicts both.

In short, the law set forth in *Amgen* and *White* is clear. Neither *Nidec* nor *Vivid Technologies* changes it. There is no law that allows Amazon to apply a favorable claim scope on invalidity but to turn around and seek to apply narrower scopes for purposes of non-infringement.

IV. THE '337 PATENT

The '337 patent describes “a voice-content control device.” Ex. 1001, 1:46. The voice-content control device “compris[es]: a voice classifying unit configured to analyze a voice spoken by a user and acquired by a voice acquiring unit to classify the voice as either one of a first voice or a second voice.” Ex. 1001, 1:48-52. The patent also discloses a “voice-content control method, comprising: acquiring a voice spoken by a user; analyzing the acquired voice to classify the acquired voice as either one of a first voice and a second voice;” Ex. 1001, 1:65-2:1.

One embodiment of the voice classifying unit “analyzes the voice V1 acquired by the voice acquiring unit 30, and classifies the voice V1 to either one of a first voice V1A and a second voice V1B.” Ex. 1001, 7:51-54. For example, the voice classifying unit can determine if a voice is a whisper or not and classify it accordingly. *see* Ex. 1001, 7:56-62 (classifying the whisper as V1A). As another example, the voice classifying unit can perform Fourier-transformation on the time waveform to determine the intensity of the voice. *See* Ex. 1001, 7:64-8:1 (“the voice classifying unit 38 acquires a time waveform of intensity of the voice V1, and performs Fourier- transformation on the time waveform, thereby acquiring a spectrum that indicates intensity of the voice V1 per frequency.”). That embodiment of the voice classifying unit can then classify the voice as a first voice

V1A or second voice V1B by “using a peak frequency that is equal to or higher than a predetermined intensity in the spectrum as a feature value.” Ex. 1001, 8:3-4.

Other embodiments of the voice classifying unit use the peak frequency of the sound waves, the volume of the voice, the speaking speed of the voice, the volume ratio between the speech and wind noise, the distance between the speaker and the device, or the mel-frequency cepstrum coefficient. *See* Ex. 1001, 8:3-34 (explaining that the voice classifying unit sets certain feature values that distinguish between different voices). Further, “[t]he voice classifying unit 38 can use either one of the classification methods explained above, or can perform the classification by combining the classification methods explained above.” Ex. 1001, 8:56-59.

V. CUMULATIVE POSITIONS

The Petition relies upon two primary references: Shin (Ex. 1003) and Shimomura (Ex. 1005):

Ground	Reference(s)	Basis	Challenged Claims
1	Shin	§102	1-5
2	Shin	§103	1-5
3	Shimomura	§103	1-5
4	Shimomura and Shin	§103	1-5
5	Shin and/or Shimomura in view of Kristjansson	§103	1-5

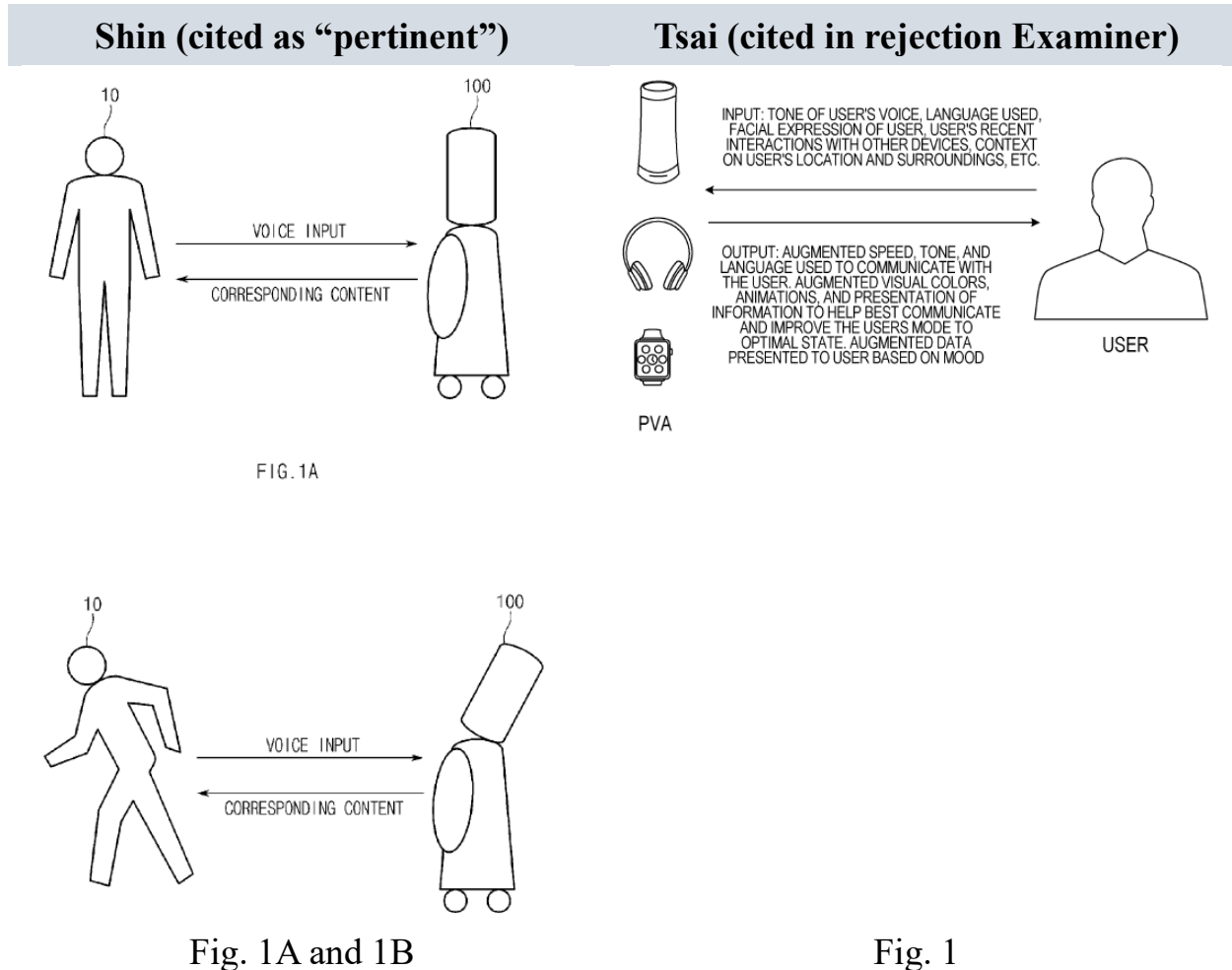
Pet., 6 (red and yellow annotations added).

The Patent Office issued the '337 patent over Shin. The Examiner considered Shin as “Pertinent Prior Art.” Ex. 2009, 176. The Examiner cited a portion of Shin that is redundant of all of the other disclosures on which Amazon relies—paragraph [0037], to be specific. Thus, the Examiner specifically allowed the challenged claims over Shin. Indeed, Shin discloses volume adjustment based upon a single user’s movements. It lacks the voice classification limitations:

In this case, since the user 10 provides a voice input with a louder volume than usual and at a faster speech rate than usual *while the user 10 moves away from the electronic device 100*, the electronic device 100 may provide the content as sound with a relatively louder output volume level and at a relatively faster output speed. As such, the user 10 may be provided with content corresponding to a voice input.

Ex. 1003, ¶[0039] (emphasis added).

Shin is also cumulative of other art upon which the Examiner already relied (e.g., Tsai (USP 20190130900)).



Amazon’s other primary reference, Shimomura, fares no better. It is also based solely on distance: “the speech form of the device during a dialogue with the user is changed *as necessary according to the distance* between the device and the user.” Ex. 1005, ¶[0012] (emphasis added). Amazon relies solely on expert testimony to attempt to disclose classifying voices based on distance. Pet., 39 (“Shimomura discloses that the voice classifying unit (control unit) analyzes the

voice to classify it as either a first or second voice based on the user-to-device distance.” (citing Ex. 1002, ¶138)).

Additionally, the Petition relies on Shimomura to assert that the claimed omitted information is disclosed in the form of “ne.” Pet., 46. But Shimomura states that such disclosure is a “change[] in intonation.” Ex. 1005, ¶[0092] (“changes in intonation (emphasis at the end of each phrase) ...”). It is not an omission of information.

VI. ARGUMENT

A. Grounds 4 and 5 Demonstrate the Deficiencies of Grounds 1 Through 3

1. Ground 4

The Petition also fails to identify other core elements of the claims, as set forth in Section VI.B below addressing Grounds 1-3. Ground 4 makes that clear.

Amazon proffers Ground 4 because neither Shin nor Shimomura discloses the use of distance and volume adjustment in the same embodiment. Amazon predicates its position as follows: “Even if Shimomura alone did not teach or motivate a POSITA to alter the output’s content and volume at the same threshold distance (*e.g.*, 350 cm), ...” Pet., 59. There are three problems here.

First, there is no “if.” The Petition never mentions or addresses any concept of “same threshold distance” in any other ground.

Second, Amazon points to no express disclosure of altering both output content and volume based on the same distance assessment in Shin or Shimomura. Its argument in that regard would have had to be one of inherency. But Amazon never made that assertion.

Third, the missing language Amazon seeks to fill in via Ground 4 does not relate to any specific claim language. Amazon does not explain how altering content and volume at a single, *numerical* threshold distance relates to the claims. It recites no applicable limitation. Nor does it identify or apply *Graham* factor 2 to any missing limitation or claim. Ground 5 contains the same deficiencies.

2. Ground 5

The deficiencies in Ground 1 are admitted by Ground 5. Ground 1 is based upon anticipation. But the Petition does not identify where the components of claim 1 are actually disclosed in Shin. The Petition focuses on *functions* without identifying what *component* allegedly accomplishes those functions. For example, the Petition describes the '337 patent's "voice classifying unit" as referring to "a CPU configured to perform the claimed function, namely, to analyze the user's voice and to classify it as a first or second voice." Pet., 11. As another example, the Petition describes the '337 patent's proximity sensor as "calculating the user-to-device distance, the distance can be used as a 'feature value' to perform the classification as the first or second voice." *Id.* Ground 1 does not address the

details or arrangement of the components/steps of any claim of the '337 patent. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1370 (Fed. Cir. 2008) (“The reference thus was deficient because it did not disclose the elements of the claimed invention ‘arranged as in the claim’ as required by 35 U.S.C. §102.”); *Incept LLC v. Palette Life Scis., Inc.*, 77 F.4th 1366, 1372 (Fed. Cir. 2023) (“To anticipate, the identical invention must be shown in as complete detail as is contained in the patent claim.” (citing *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (citation modified))); *Galderma Labs., L.P. v. Teva Pharm. USA, Inc.*, 799 F. App’x 838, 844 (Fed. Cir. 2020) (regarding method claims, “What a POSA ‘envisages’ from reading a reference is relevant to whether a reference discloses the claim elements ‘arranged as in the claim.’”); *Tf3 Ltd. v. Tre Milano, LLC*, 894 F.3d 1366, 1374 (Fed. Cir. 2018) (regarding a method claim, “Not only must each claim element be shown in a single reference, but the elements must be ‘arranged or combined in the same way as recited in the claims.’”).

Amazon tacitly admits that deficiency in Ground 5. Amazon introduces Kristjansson in Ground 5 to assert disclosure of certain recited components that perform certain functions. But even then, Amazon fails to address the independent claims. It only attempts to identify *a few* of the recited components in dependent claim 2. Pet., 65-68 (*e.g.*, “intention analyzing unit” and “acquisition content information acquiring unit”). The Petition only applies Kristjansson to claim 2[a].

It skips claims 1 and 3-5. But even that attempt is cursory. Amazon spends most of its pages repeating incomplete obviousness rationales. Pet., 66-68.

In short, Amazon admits, via Ground 5, of the necessity to identify the detailed arrangement of components/steps recited in the other claims. But it failed to do so in Ground 1. Those deficiencies apply to every other ground that builds on Ground 1. Pet., 30 (Ground 2 incorporating Ground 1), 59 (Ground 4 incorporating Ground 1), 65 (Ground 5 incorporating Ground 1).

B. No Voice Classification

1. Ground 1

Ground 1 fails because Shin does not disclose voice classification. Amazon and its expert add them in (see red annotations):

TABLE 3	
	Distance (D) between user and electronic device
First Voice	$D < 1\text{ m}$
	$1\text{ m} \leq D < 2\text{ m}$
	$2\text{ m} \leq D < 3\text{ m}$
	$3\text{ m} \leq D < 4\text{ m}$
Second Voice	$D \geq 4\text{ m}$

Pet., 14; Ex. 1002, ¶¶64, 77, 81.

Amazon does not expressly state that its lawyers/expert added the red portions (“First Voice” and “Second Voice”). As shown below, Shin does not include the same annotations:

TABLE 3

Distance (D) between user and electronic device	Output amount of information of content
D < 1 m	Amount of information of original content
1 m ≤ D < 2 m	Content of first abbreviation level
2 m ≤ D < 3 m	Content of second abbreviation level

TABLE 3-continued

Distance (D) between user and electronic device	Output amount of information of content
3 m ≤ D < 4 m	Content of third abbreviation level
D ≥ 4 m	Content of fourth abbreviation level (abstract content)

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Ex. 1003, Table 3.

The table also confirms that it addresses one variable (D) in terms of one “user.” There is no variable related to different users. (The same will be true of Shimomura and its related grounds.)

Amazon explains the distinction between the ’337 patent and Shin. Amazon summarizes Shin as disclosing a device that “used cameras to determine the distance between the device and *the* user” and “classified *the* user’s speech based on distance.” Pet., 2 (emphasis added). By contrast, Amazon admits that the ’337 patent uses a voice classifying unit to “analyze the user’s voice and to *classify* it as *a first or second voice*.” Pet., 11 (emphasis added).

Amazon asserts that “Shin discloses that the voice classifying unit (processor) analyzes the voice to classify it as either a first or second voice based on the user-to-device distance.” Pet., 13 (citing Ex. 1002, ¶63). But it points to no disclosure of Shin doing any such thing.

Shin discloses “determin[ing] an output scheme of content based on the distance between the user and the electronic device.” Ex. 1003, ¶[0078]. Further,

“an output amount of information of the content decreases as a distance between the user and the electronic device 101 increases and such that the output amount of information of the content increases as the distance between the user and the electronic device 101 decreases.” Ex. 1003, ¶[0086]. Based on Table 3, the output of information is directly correlated to how far a user is from Shin’s device.

The Petition attempts to spin Shin’s different outputs based on distance into a disclosure of first and second voices. Pet., 14. Amazon’s argument fails. Shin is incapable of distinguishing multiple voices.

If Shin had disclosed classification of voices, it would have done so expressly. It would have used the same language it used to explain other distinctions. Shin states that “[t]he terms, such as “first”, “second, and the like, as used herein, may refer to various elements of embodiments of the present disclosure, but do not limit the elements.” Ex. 1003, ¶[0027]. The patentee of Shin thus knew how to disclose the categorization of two things. And did so, for example, when disclosing two separate devices. *Id.* (“For example, ‘a first user device’ and ‘a second user device’ *indicate different user devices*, regardless of the order or priority of the devices.” (emphasis added)).

Shin never refers to a “first user” or “second user” or “multiple users.” *See generally* Ex. 1003. Instead, Shin discusses how “a user 10, who is spaced apart from an electronic device 100 by a specific distance and is at a standstill, may

“speak to the electronic device 100.” Ex. 1003, ¶[0037]. The same “user 10 who moves away from the electronic device 100 may speak to the electronic device 100.” Ex. 1003, ¶[0038].

The patentee of Shin also knew how to disclose classifications. Shin does so when addressing content. Shin states that “[t]he detailed *content* and the abstract content may be classified dichotomously.” Ex. 1003, ¶[0051] (emphasis added). Content is output. Voices, by contrast, are input. Thus, Shin fails to disclose any type of classification required by the claims.

2. Ground 2

Ground 2 is moot.

As a threshold matter, Amazon’s lead-in to Ground 2 is completely improper. It is a cursory and generalized attempt at a catchall: “If PO argues that Shin fails to disclose *any* limitations, such limitations would have been obvious over Shin.” Pet., 30 (emphasis added). That position is generalized. It is not developed. And it improperly conflates anticipation and obviousness. Obviousness and Anticipation are two separate legal concepts with different requirements and elements. *See* §VI.G.2. *infra*. Failure to Provide Fair Notice (discussing how obviousness and anticipation cannot be conflated).

The only obviousness ground actually disclosed is based upon one inapplicable disclosure missing from Shin: the lack of disclosing two and only two

classifications. No party asserts that the '337 patent claims require classification of two and only two voices. Thus, Ground 2, to the extent properly asserted, is moot. And Amazon's attempt at a conclusory catchall, "[i]f PO argues that Shin fails to disclose any limitations, such limitations would have been obvious over Shin[]", should be disregarded. Pet., 30.

Ground 2 also fails substantively. Briefly stated—given that it is moot—Petitioner identifies the wrong missing limitation in claim 1. Pet., 30 (“Even if PO were to argue that claim 1 requires the user’s voice to be classified into no more than two classifications based on distance...”). The '337 patent specifically does not limit classifications based on distance. *See, e.g.*, Ex. 1001, 7:56-62 (classifying voices as either a whisper or not a whisper). Modifying table 3 as Petitioner suggests would limit the amount of outputs. That is not what the claims recite. The claims recite classification of input voices.

3. Ground 3

According to the Petition, the Shimomura discloses “that the voice classifying unit (control unit) analyzes the voice to classify it as either a first or second voice based on the user-to-device distance.” Pet., 39. Amazon's Shimomura grounds suffer the same deficiencies as its Shin grounds. Shimomura also takes one voice and determines an output. The output is what is changing; it does not differentiate between the voices.

Shimomura instead recognizes how far away a “conversation partner” is. *See* Pet., 39 (“These units may ‘transform the character string’ of the content spoken by the robot or change its volume ‘according to the distance to the conversation partner.’”). All processing in the Shimomura is then based on distance. *See* Ex. 1004, ¶¶[0060]-[0064] (“string transformation unit transformation unit 51 is given character string and *distance* information from the behavior selection control unit...” (emphasis added) and explaining how distance determines output).

The Shimomura device does not classify voices. Pet., 40 (citing Ex. 1004, ¶[0040]). Amazon thus makes the same incorrect argument in connection with Shimomura—which is cumulative of Shin on this point:

[FIG. 7]

Second Voice	First Voice
Less than 350 cm	350 cm or more
None	Implementation

Pet., 40; Ex. 1002, ¶139.

Again, Shimomura does not include the red portions that assert to be “Second Voice” or “First Voice”:

[FIG. 7]

Less than 350 cm	350 cm or more
None	Implementation

FIG. 7 Character string transformation determination table

Ex. 1004, 17 (Fig. 7). Thus, the weakness of the Petition is as plain as Amazon's red annotations.

Shimomura does not disclose volume adjustment in the manner Amazon asserts. Shimomura discloses that volume and intonation (ne) adjustments are disarticulated from one another. That is the intention. Shimomura discloses separate tables (Tables 7 and Table 9) to do so. A POSITA would have understood that the manner in which the intonation (ne) changes based on distance would be separate and apart from the manner in which the volume changes based on distance. Thus, modifying either Table 7 or Table 9 as Amazon suggests would undermine the purpose of Shimomura. *See* §II.C. *supra* (prior art must be considered as a whole). A POSITA would have had no reason to do it.

Petitioner argues that “Shimomura discloses that the voice classifying unit (processor) is configured to analyze the voice to classify the voice as either one of a first voice (*e.g.*, farther than 350 cm) or a second voice (*e.g.*, closer than 350 cm) based on the distance between the user and the device. (Ex. 1002, ¶¶136-40.)” Pet., 40.

However, Shimomura only calculates distance. It classifies outputs based on that distance. It cannot, for example, differentiate based on the type of sound or which voice is speaking.

Amazon's obviousness position is limited to one aspect (under the second *Graham* factor): modifying the volume of output sentences. That position relies upon bare recitation of incomplete obviousness rationales. Pet., 47-50. It makes an attempt to address predictable results and reasonable expectation of results. *Id.*, 50-53. But the Petition merely recreates what the combination would *be*—in hindsight. It does not state how or why a POSITA would have expected it to work, especially without defeating the purpose of Shimomura. Amazon's expert does not fill in the gaps or provide any additional information. The declaration merely mirrors attorney argument in the Petition. *See* § VI.F.2 *infra* (discussing how the expert declaration should be given little to no weight because it mirrors the Petition).

C. Failure to Support Inherency Arguments

Amazon identifies no disclosure of voice classification—at least beyond the annotations provided by the Petition and expert declaration. Thus, it is actually an attempt at inherency in Ground 1, without any application of facts or law in support. To anticipate a claim, a prior art reference must disclose each and every element of the claim, “either explicitly or inherently.” *ADASA Inc. v. Avery*

Dennison Corp., 55 F.4th 900, 910 (Fed. Cir. 2022) (citing *Eli Lilly & Co. v. Zenith Goldline Pharms., Inc.*, 471 F.3d 1369, 1375 (Fed. Cir. 2006)).

It is completely missing—not asserted as a *Graham* factor two difference—in every other ground.

The Petition demonstrates how to disclose an inherency argument when necessary. It states as much in connection with the “processing executing unit.” Pet., 25 (“Shin inherently discloses it.”), 26, 41, 53, 54. It does not rely upon inherency in connection with any other limitation or claim. Inherency cannot be established by “probabilities or possibilities.” *LBT IP I LLC v. Apple Inc.*, Nos. 2022-1613, 2022-1614, 2022-1615, 2022-1616, 2022-1617, 2023 U.S. App. LEXIS 14376, at *10 (Fed. Cir. June 9, 2023) (citing *PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1195 (Fed. Cir. 2014)). Nor can it be established by what “a skilled artisan would understand.” *Id.*

Amazon identifies no express disclosure of voice classification in place of inherency or obviousness, in any reference. The closest disclosure it can find relates to classification of *content*. Shin states that “content may be classified dichotomously.” Pet., 14; Ex. 1003, ¶[0051]. But that demonstrates, by comparison, Amazon’s failure to identify any express disclosure of “classification” of “voices.”

D. Misstatement of the Record and Internal Contradictions

Amazon misstates the record. Amazon cites to the '337 patent's disclosure of classifying voices based upon a "feature value." Pet., 11 (citing Ex. 1001, 8:20-26 and 8:30-34). That value (mel-frequency cepstrum coefficient (MCFF)) is something that differs from person to person. It makes MCFF an obvious candidate for use in user identification. Amazon omits that crucial portion of the disclosure (*see* Ex. 1001, 8:26-30 omitted by Amazon). Amazon asserts that "Shin discloses the same thing" as MCFF when it calculates a distance. Pet., 11. That is not credible. Distance may be used in conjunction with MCFF to identify a user. But arguing that MCFF and distance is the "same thing" is not credible.

Amazon asserts that Shin discloses a voice classifying unit "to analyze the *voice* to classify the voice as either one of a first voice ... or a second voice." Pet., 14 (emphasis added). That directly contradicts other statements in the Petition. *Compare* Pet., 9 ("Shin's device includes a 'distance detection module' that compute[s] a distance between a user and the electronic device.") *with id.*, 14 ("Shin discloses classifying the voice as a 'first voice' when the distance is less than 1 meter, and a 'second voice' when the distance is greater than 4 meters.").

E. Legally Insufficient Obviousness Case (Grounds 2-5)

1. Failure to *Apply* Second Graham Factor

Amazon fails to meet *Graham* factor two in its obviousness analysis for Grounds 2-5. The Petition does not identify “the differences between the claims and the prior art.” *Arctic Cat Inc. v. Bombardier Rec. Prods.*, 876 F.3d 1350, 1358 (Fed. Cir. 2017) (citing *Graham*, 383 U.S. at 17-18). Amazon is required to address all four *Graham* factors in its obviousness analysis. *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1328 (Fed. Cir. 2016) (“A determination of whether a patent claim is invalid as obvious under § 103 requires consideration of all four *Graham* factors, and it is error to reach a conclusion of obviousness until all those factors are considered.” (citations omitted)).

Graham factors one and two go hand-in-hand. Motivation to combine and expectation of success are generally considered as part of the first factor. *Dystar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1370 (Fed. Cir. 2006). It is not possible to determine whether a POSITA would have been motivated to combine references, or had a reasonable expectation of success / predictable results, without *specifically* identifying and addressing the difference—or “gaps”—between the claims and the art. It is necessary to determine whether it would have been obvious “to bridge the gaps between the prior art and the claims.” *Apple Inc.*

v. Samsung Elecs. Co., Ltd., 839 F.3d 1034, 1061 (Fed. Cir. 2016); *Pfizer Inc. v. Sanofi Pasteur Inc.*, 94 F.4th 1341, 1348 (Fed. Cir. 2024).³

Amazon does not explain what specifically is missing from the primary references, where it is found, or why a POSITA would have been motivated to bridge the gap. Amazon does not sufficiently address *Graham* factor two at all. It provides boilerplate recitations in support of factor one and then proceeds to simply identify alternative disclosures for each limitation. That approach violates *Graham* and *KSR*. One cannot merely point to disparate disclosures between multiple references and presume a POSITA would have been motivated to, or could with reasonable success, piece the references together in some unarticulated way to make it work.

The Petition only addresses *Graham* factor two (differences between the claimed invention and the prior art) in limited and isolated instances. For example, the Petition raises six different potential combinations in Grounds 1-5. And it proposes obviousness grounds to invalidate every limitation of every claim. But

³ See also, e.g., MPEP 2143 (every example of “rationales” requires an assessment of “difference[s] between the claimed invention and prior art,” how prior art “differed from the claimed device,” what “improvement” that claimed device lacked, identifying a finite number of potential “improvements,” or identifying a “modif[ication]” to be made).

the following are the only instances in which the Petition attempts to provide a position on *Graham* factor two.

In Ground 2, Amazon states “[e]ven if PO were to argue that claim 1 requires the user’s voice to be classified into no more than two classifications based on distance, Shin renders this obvious.” Pet., 30. Amazon acknowledges that “claim 1 requires the user’s voice to be classified into no more than two classifications based on distance...” as a difference between the claimed invention and the prior art. *Id.*

In Ground 3, Amazon states that “[a]lthough Shimomura generally discloses altering the volume based on distance, it does not specify that the *output sentences have different volumes.*” Pet., 47.

In Ground 4, Amazon states that “Even if Shimomura alone did not teach or motivate a POSITA to *alter the output’s content and volume at the same threshold distance . . .*” Pet., 59 (emphasis added).

In Ground 5, Amazon states that “[s]pecifically, to the extent PO argues that Shin and/or Shimomura do not disclose the “*process executing unit*” limitations (e.g., claim limitations 1[c], 2[a], 4[d], and 5[d]), Kristjansson discloses those limitations and renders the claims obvious.” Pet., 65 (emphasis added).

SoundClear does not contend that claim 1 requires two and only two classifications; thus Ground 2 is cumulative of Ground 1, the Shin anticipation

ground. Amazon makes no obviousness argument other than modifying Shin to have two and only two classifications. As described above, Ground 4 at most identifies a difference between two references. It does not identify the difference between any reference and the *claims*, as required under Graham 2.

Thus, the Petition fails to establish a prima facie case of obviousness beyond the following: (1) for Ground 3, that Shimomura would have been modified to include different volumes for different output sentences and (2) for the incomplete, multiplicative, alternative Ground 5, that Kristjansson's process executing unit be combined with the logic in Shin, Shimomura, or the combination of Shin and Shimomura.

Alternatively, if the Petition is instituted, SoundClear respectfully requests that the Board identify each applicable difference between each claim and the prior art. That is, make sure the parties and the Board are all on notice of how Amazon applies *Graham* factor 2 (*i.e.*, the specific differences for which secondary references are added) in its prima facie case.

2. No reason for the combinations

Amazon indiscriminately selects disclosures from its various references to attempt to piece together the claim limitations. The Petition never addresses why a POSITA would have seen any reason to combine or modify the references to fill in those gaps. In contrast, doing so would defeat the core purpose of the disclosures.

Amazon does not address those problems, because its Petition never analyzes the claims as a whole. It simply focuses on discrete disclosures. When addressing Shin and Shimomura in combination, for instance, it zooms in on two tables without any discussion of the larger purpose or context of any claimed invention. *See* §II.C. *supra* (discussing improper hindsight).

Amazon never identifies either (1) what problem a POSITA would have sought to solve when combining references or (2) any non-redundant benefit disclosed in them. *Id.* An inquiring party might ask why Amazon asserts that a POSITA would have combined Shin and Shimomura and possibly Kristjansson. There is no answer in the Petition—as discussed below.

3. Obviousness Arguments are perfunctory

The Petition does not establish that any results would have been predictable or any reasonable expectations of success. In many instances, the Petition merely recites the words “predictable” or “reasonable expectation” without providing any support or explaining how or why these results would have had any reasonable expectation of success. *See, e.g.*, Pet., 31, 32, 34, 48, 49, 50, 57, 58, 60, 61, 63, 64, 67. Those sorts of statements lack support and are legally insufficient. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013) (“Even assuming that a person of ordinary skill might have some motivation to [combine], the record does not show any reasonable expectation that this significant change would be

successful.”); *A/S v. Coolit Sys. Inc.*, No. 19-cv-00410-EMC, 2022 U.S. Dist. LEXIS 246288 at *23-24 (N.D. Cal. Sep. 11, 2022) (the following “conclusory sentence” insufficient: “[w]hen the cited references are combined or modified as a POS[IT]A would have been motivated to do, the combination or modification is also based on conventional or known methods that would have yielded predictable results and been reasonably expected to be successful by a POS[IT]A.’ ... This conclusory assertion is insufficient show reasonable expectation of success.”).

The Petition provides generalized and conclusory assertions of obviousness. That much is clear from the fact that the language in the Petition is virtually identical to that of Amazon’s expert. They constitute neither opinion nor analysis. Setting that problem aside, they constitute incomplete, boilerplate restatements of some of the exemplary motivation-to-combine rationales set forth in MPEP § 2143.

Further, the only facts alleged describe the same desire to create a simplified product that is inherent in every development project:

- “simplifying complex systems into fewer categories . . .” Pet., 31.
- “to simplify user experience.” Pet., 31.
- “simplifying implementation and minimizing computational demand.” Pet., 32.
- “simplifies design by minimizing programming complexity.” Pet., 49.
- “simplifying design” Pet., 61.

- "perform these functions more efficiently" Pet., 55.
- "an efficient, user-friendly solution" Pet., 31.
- "a streamlined, efficient, and straightforward user interface" Pet., 31.
- "efficient, streamlined interactions" Pet., 34.
- "to configure the processor for more efficient and streamlined interactions." Pet., 35.
- "perform these functions more efficiently" Pet., 55.
- "excessive repetition would be inefficient" Pet., 57.
- "efficient intent extraction and content retrieval" Pet., 62.

Each fails as a matter of law. Making systems simpler and more efficient are two related, ubiquitous concepts. They lack any particular meaning in an obviousness analysis. *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-00582, Paper 34, 21-22 (PTAB Aug. 5, 2019) (informative decision) ("a generic desire for 'improved access times' is 'merely a bald statement ...'). "The factual inquiry whether to combine references must be thorough and searching, and the need for specificity pervades this Court's authority on the Board's findings on motivation to combine." *Id.*, (citation modified); *In re Kahn*, 441 F.3d 1977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational

underpinning to support the legal conclusion of obviousness.” (emphasis added)); *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

F. Grounds 4 and 5

1. Improper Circumvention of Obviousness and Anticipation

Grounds 4 and 5 appear to be attempts to avoid the proper obviousness and inherency standards. Amazon discloses those grounds in quick, cursory fashion. Pet., 59-67. The large majority of the applicable pages in the Petition is spent repeating around eight incomplete versions of the obviousness rationales from MPEP § 2143.

Amazon asserted that a POSITA would have combined the references for the purpose outputting content and volume at a single, *numerical* threshold distance. The Petition does not explain, however, how that combination/modification relates to any claim limitation. Instead, Amazon is attempting to create an artificial steppingstone between assessing the prior art and the claims. That approach undermines established precedent against hindsight reasoning, using the invention as a roadmap to piece together the invention.

2. Failure to Provide Fair Notice

Amazon’s Petition and expert declaration each repeatedly state contradictory alternative positions without differentiating between the two: “known and obvious,” “anticipate and render obvious,” “disclose and render obvious,”

“disclose or render obvious.” *See, e.g.*, Pet., 59, 62, 64-65, 69; Ex. 1002, ¶¶175, 186, 198, 216, 217 (*e.g.*, “Shin and Shimomura disclose and/or render obvious each limitation”). That is confusing, non-committal, multiplicative language.

The APA “requires that the parties to IPRs receive notice of arguments and evidence and have an opportunity to be heard.” *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1001 (Fed. Cir. 2023); *see* 5 U.S.C. § 706. So does the AIA, which requires a petition to state “in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). The petition “must provide an understandable explanation of the element-by-element specifics of the patentability challenges, including the identification of particular portions of prior art on which the petitioner is relying.” *Corephotonics*, 84 F.4th at 1001. “[I]t is the petitioner’s burden to present a clear argument.” *Apple Inc. v. Gesture Tech. Partners, LLC*, 129 F.4th 1367, 1375 (Fed. Cir. 2025).

Obviousness and anticipation are separate and distinct grounds with separate statutory requirements. *See SNF S.A. v. Chevron U.S.A.*, IPR2022-01534, Paper 46, 18-19 (PTAB Apr. 18, 2024); *Cohesive Techs., Inc. v. Waters Corp.*, 543 F.3d 1351, 1364 (Fed. Cir. 2008) (explaining how “[t]he tests for anticipation and obviousness are different.”). They “require[] different tests and different elements of proof.” *Minkin v. Gibbons, P.C.*, 680 F.3d 1341, 1351 (Fed. Cir. 2012).

A reference anticipates if it “disclose[s] each and every limitation of the claimed invention, either expressly or inherently.” *SRI Int’l, Inc. v. Cisco Sys., Inc.*, 930 F.3d 1295, 1306 (Fed. Cir. 2019). In contrast, every obviousness ground requires weighing “(1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the art; and (4) objective considerations of nonobviousness.” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1358 (Fed. Cir. 2017) citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)). And since “it is error to reach a conclusion of obviousness until all of those factors are considered” (*id.*), a “technically anticipated invention” need not be obvious. *Cohesive Techs.*, 543 F.3d, 1364.

Amazon and its expert use alternative phrasing that invokes both anticipation and obviousness. But they explain neither. They use those arguments to preface discussions about the alleged disclosures. But they do not apply any applicable legal standard for anticipation (*e.g.*, express or inherent) or obviousness (*e.g.*, single-reference⁴ or in combination). They fail to address any specific *Graham* factor. For example, Amazon’s position that all elements are disclosed

⁴ *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1362 (Fed. Cir. 2016) (explaining legal standard that applies even for missing disclosures that are “unusually simple”).

implicitly asserts that there are no differences between the claims and the prior art; whereas *Graham* factor 2, in direct contrast, requires that those differences be expressly identified. *See Arctic Cat*, 876 F.3d, 1358. Alternative positions are sometimes appropriate. But not when they are stated in a shrouded and inseparable manner. Neither Amazon nor its expert ever addressed the differences between the claims and the prior art. Neither explained why the claimed combinations would have been obvious despite any unidentified differences.

The Petition thus fails to fairly disclose its arguments, fails to articulate any reasoning to support it, fails to establish a *prima facie* case, and contradicts positions required under *Graham*. In short, the Petition provides no basis for invalidating the patents without requiring that the Board commit reversible error.

The Petition relies solely on indeterminate statements to address important claim limitations (*e.g.*, voice classification and operations based on it). The language in the Petition mirrors statements in the expert declaration in that regard. So, it is not clear whether the statements are intended to constitute expert opinion, legal argument, or something else. *Compare* Ex. 1002, ¶¶117-120 *with* Pet., 32-35 (Ground 2); *Compare* Ex. 1002, ¶¶129-197 *with* Pet., 35-59 (Ground 3); *Compare* Ex. 1002, ¶¶199-204 *with* Pet., 59-64 (Ground 4); *Compare* Ex. 1002, ¶¶216-223 *with* Pet., 65-68 (Ground 5).

Amazon’s expert declaration should thus be given little or no weight. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15-17 (PTAB Aug. 24, 2022) (designated precedential) (according “little weight” to declaration testimony that contains a verbatim restatement of a petition’s conclusory assertions without additional supporting evidence or reasoning); *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1340–41 (Fed. Cir. 2020) (affirming Board decision giving no weight to expert testimony that “merely repeated petitioner’s argument, nearly verbatim, without citation to the basis for his testimony”).

The expert/attorney statements are conclusory and unsupported. They do not rely on any express disclosure for “voice classification.” They do not argue that it is inherent in either reference. It follows that the dependent claims are also not obvious. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious.”). Thus, the Petition fails for those reasons alone.

3. Modifying Outputs Does Not Disclose Classification of the Claimed Inputs

Amazon’s Ground 4 states that “[e]ven if Shimomura alone did not teach or motivate a POSITA to alter the output’s content and volume at the same threshold distance (e.g., 350 cm), doing so would have been obvious in view of Shin.” Pet., 59. Ground 5 builds on that concept but cites Kristjansson regarding processing components. *See* Pet., 65.

Amazon argues that a “POSITA would have naturally combined these teachings to enhance adaptability and functionality in voice-controlled devices with predictable results.” Pet., 60. That statement is entirely based on the expert declaration which, as explained above, mirrors the Petition.

It is also inapposite. Adjusting the outputs does not address the missing limitation of classifying inputs (voices).

G. Ground 5

Ground 5 should be separated into at least three different Grounds because of the use of “and/or.” Ground 5 in the Petition states, “Claims 1-5 Would Have Been Obvious Over Shin And/Or Shimomura in View of Kristjansson.” Pet., 65. Using “and/or” in a ground combining two references creates confusion. It leaves open the possibility of three combinations:

- i. Shin and Kristjansson;
- ii. Shimomura and Kristjansson; and
- iii. Shin, Shimomura, and Kristjansson.

Ground 5 also fails as a matter of law. It omits every step of the obviousness analysis that the Supreme Court mandates.⁵ Indeed, the petitioner has the burden

⁵ *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (citation omitted)).

“show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring inter partes review petitions to identify “with particularity ... the evidence that supports the grounds for the challenge to each claim”)). The burden of persuasion does not shift to the patent owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Further, “it is the petitioner’s burden to present a clear argument.” *Apple Inc. v. Gesture Tech. Partners, LLC*, 129 F.4th 1367, 1375 (Fed. Cir. 2025). The patent owner should not be required to guess the manner in which the Petition combines references.

Shin, Shimomura, and Shin-Shimomura each constitute a separate obviousness ground when combined with Kristjansson. Fairness dictates⁶ that the Board require that petitioners disclose their grounds with particularity and assess them as required under *KSR* and *Graham*. Amazon has not done so.

⁶ *See position Dell Inc. v. Acceleron, LLC*, 818 F.3d 1293, 1301 (Fed. Cir. 2016); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015) (“A patent owner in [an IPR] is undoubtedly entitled to notice of and a fair opportunity to meet the grounds of rejection.”) (explaining Administrative Procedure Act (“APA”) requirements, including that respondents be “timely inform[ed]” of “matters of fact and law asserted,” which mean that an agency “may not change theories in midstream without giving respondents reasonable notice of the change and the opportunity to present argument under the new theory”) (internal citations and quotations omitted).

Petitioner acknowledges that “to the extent PO argues that Shin and/or Shimomura do not disclose the ‘process executing unit’ limitations (e.g., claim limitations 1[c], 2[a], 4[d], and 5[d]), Kristjansson discloses those limitations and renders the claims obvious.” Pet., 65. Again, using the phrase “Shin and/or Shimomura” is confusing and unclear. That said, the limitation that Petitioner is trying to fill with these combinations of references is the “process executing unit.”

Petitioner’s combinations fail for multiple reasons. First, Petitioner does not explain *how* Kristjansson’s NLU teachings would be successfully integrated into Shin and Shimomura’s systems. The NLU described in the Kristjansson reference is used to execute commands such as “call mom” and is connected to different devices. *See* Ex. 1013, 8:1-10 (tagging “call” in “call mom” as a command). Further, “[t]o correctly perform NLU processing of speech input, an NLU process 460 may be configured to determine a ‘domain’ of the utterance so as to determine and narrow down which services offered by the endpoint device (e.g., server 120 or device 110) may be relevant.” Ex. 1013, 8:11-15. Accordingly, the speech input is being processed to determine endpoint services. *Id.*

The device disclosed in Kristjansson uses sound pressure to detect audio inputs. Ex. 1013, Abstract (“The device detects the sound pressure of a spoken utterance at the device location and determines the distance of the user from the device.”). Meanwhile, the ’337 patent, as explained above, can analyze voices

through multiple methods. *See* §IV.F. *supra* ('337 Voice Classification). This is why it is even more important for Petitioner to explain how the processing unit of Kristjansson's device fits with Shin and/or Shimomura to disclose the invention. *See Unigene Labs.*, 655 F.3d at 1360 ("[o]bviousness requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination").

Petitioner uses improper obviousness arguments to construct Ground 5. These glaring deficiencies show why there is no reasonable likelihood that Petitioner would prevail with respect to even 1 challenged claim.

H. Improper Certificate of Translation

Amazon relies upon a translated Japanese reference without laying the proper foundation for the translation. *See* Ex. 1005. The certification does not identify whether the signatory, Ms. Snorteland, is a translator or is fluent in Japanese. It does not state how the translation was performed. It does not even identify *who* performed the translation.

Those are a material deficiencies. They are especially acute in the context of Amazon's Petition. The Petition relies heavily upon purported expert testimony to address the lack of express disclosures in Shimomura. The lack of express disclosures elevates the potential for dispute over the context in which specific words are used. Such disputes go beyond whether a translation is certified as either

true or not. They proceed into the realm of expert testimony. *See, e.g., Kurotaki v. United States*, No. 22-00063 MWJS-WRP, 2024 U.S. Dist. LEXIS 215953, at *13-*15 (D. Haw. Nov. 27, 2024) (distinguishing between lack of dispute over “proper translation” versus expert testimony as to “different linguistic connotations” of a “properly translated” Japanese word); *see also Hayashi v. Ozawa*, No. 17-cv-2558 (AJN), 2018 U.S. Dist. LEXIS 53559, at *5 (S.D.N.Y. Mar. 19, 2018) (“This case turns primarily on whether a particular Japanese word for ‘doctor’ refers only to people with medical degrees. The Court has no basis to rule on that question, and it will likely require the testimony of experts to aid the trier of fact in determining whether that is true.”). Ms. Snortleand has not laid the foundation for her understanding of the Japanese language (*e.g.*, fluency), let alone laid the foundation for her qualification as an expert. *Kurotaki*, 2024 U.S. Dist. LEXIS 215953, at *15.

Further, in the era of AI-based language models, it is particularly necessary to lay the foundation for how translations are performed. Ms. Snorteland is a translator with TransPerfect, Inc. Ex. 1005. TransPerfect advertises services in which humans assist with AI-generated translations. Ex. 2010 (“That’s why a human-in-the-loop (HTL) approach, involving subject matter experts, is essential to validate AI-generated content.... TransPerfect IP combines advanced NMT

technology with human expertise to deliver high-quality, cost-effective patent translations and support across the IP lifecycle.”).

VII. CONSTITUTIONAL ISSUES

SoundClear objects to the use of *inter partes* review in a manner that it violates the due process rights of patent owners; that is, as an unconstitutional mechanism for challenging the validity of existing patents. Specifically, the PTAB’s rules and procedures, as applied, violate the Fifth Amendment’s guarantees of due process by depriving patent owners of their vested property rights without fundamental fairness and procedural safeguards afforded by Article III courts. Those concerns are particularly acute in this case for at least five reasons.

First, the Petition relies almost entirely upon expert testimony. It is offered in a manner that is indistinguishable from conclusory attorney argument. That testimony should be subject to evidentiary standards in view of a presumption that the ’337 patent is valid. IPR proceedings, by contrast, indiscriminately apply a preponderance of the evidence standard to determine patent validity—a lower burden of proof than the district court would apply. They do not apply *Daubert* or other evidentiary standards to protect against unreliable expert opinions. Nor do they provide the ability to cross-examine witnesses or other standards for admissibility of evidence. In short, they remove many of the protections that should be afforded to duly issued patents. *See, e.g.*, FAQ 21 (“The statute and our

reviewing court require that petitions be based on prior art patents and printed publications. As the judges have technical and legal expertise, it is not necessary for an expert to explain every aspect of the prior art.”).

Second, and relatedly, the Board renders decisions on the basis of paper briefs without live witness testimony and live cross-examination. The Consolidated Trial Practice Guide (Nov. 2019)⁷ allows parties to request live testimony and live cross-examination in the presence of an administrative patent judge. However, according to the rules, live testimony will be allowed only in limited circumstances, not as a matter of right. *Id.* (explaining that requests for live testimony will be approached by the Board on a “case-by-case” basis and outlining factors the Board may consider). In practice, the Board has no intention of incorporating live testimony into hearings. *See K-40 Elecs., LLC v. Escort, Inc.*, IPR2013-00203, Paper 34, 2 (PTAB May 21, 2014) (precedential) (“The Board does not envision that live testimony will be necessary at many oral arguments.”). Additionally, credibility is still a question best answered by juries. *See Enplas Display Device Corp. v. Seoul Semiconductor Co.*, 909 F.3d 398, 406 (Fed. Cir. 2018) (jury made a credibility determination after hearing conflicting expert testimony).

⁷ Consolidated Trial Practice Guide (Nov. 2019), *available at* <https://www.uspto.gov/patents/ptab/trials/practice-guides> (“CTPG”).

That goes beyond the issues with experts, as discussed above. It extends to all factual disputes. That would include disclosures in the prior art (*e.g.*, whether they are inherent), assessments of technical issues, motivations to combine, predictable results and reasonable expectations of success, and secondary considerations of nonobviousness. Patent owners have limited ability—constrained mostly to word-limitations in written briefs—to confront witnesses and challenge their credibility. The Board has limited ability to assess witness foundation or credibility.

Third, the inability to appeal the Board’s institution decision to an Article III court exacerbates due process concerns. Once an IPR is instituted, it can significantly alter the patent owner’s rights. In this instance, institution alone will delay adjudication of SoundClear’s case involving U.S. Patent No. 9,223,487 by two or three years. SoundClear will have no recourse. That decision will be insulated from Article III review.

Fourth, the Board lacks the adjudicative independence of an Article III court. For example, the USPTO Director is a political appointee. That position directly controls IPR outcomes through practices outside the control or participation of patent owners.

Fifth, IPR proceedings deprive patent owners of their Seventh Amendment right to a jury trial and to have the validity of patents determined in Article III

courts in view of the Supreme Court’s recent decision in *SEC v. Jarkesy*, 603 U.S. 109, 144 S. Ct. 2117 (2024).

For these reasons, SoundClear submits that the due process violations render IPR proceedings unlawful and preserves its right to challenge the constitutionality of the IPR, including before an Article III court.

As stated in the Patent Owner’s Request for Discretionary Denial, the Examiner already considered Shin. Paper 6, 45-52. And Shimomura is no more than cumulative of Shin. *Id.* Thus, reconsidering the same argument made before the Examiner counters the presumption that patents are presumed valid and the Patent Office’s expertise in its core function. *See Microsoft Corp. v. I4I Ltd. P’ship*, 564 U.S. 91, 102 (2011) (“[B]y the time Congress enacted [35 U.S.C.] § 282 and declared that a patent is ‘presumed valid,’ the presumption of patent validity had long been a fixture of the common law”).

VIII. CONCLUSION

For all of the foregoing reasons, the Petition fails to demonstrate a reasonable likelihood that any of the challenged Claims 1-5 of the ’337 patent are unpatentable.

Dated: June 12, 2025

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Brief in Support of Discretionary Denial complies with the type-volume limitations of 37 C.F.R. §§ 42.24(b)(1) because it contains 10,889 words, as determined by the word-processing program used to prepare the brief, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a)(1).

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S
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